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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/581,992	01/02/1996	FRANK J. PELLEGRINO		7356

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ROBERT W FLETCHER
10503 TIMBERWOOD CIRCLE
SUITE 114
LOUISVILLE, KY 40223

EXAMINER	
KAZIMI, HANI M	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/581,992	PELLEGRINO ET AL.	
	Examiner	Art Unit	
	Hani Kazimi	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on April 6, 2005.

Status of Claims

2. Of the original claims 1-18, and the added claim 19, claims 1 and 11 have been amended by Applicants' amendment filed on December 21, 1998. In the amendment filed on October 6, 2003, claim 19 has been canceled. Claims 1 and 11 have been amended in the amendment filed on April 6, 2005. Therefore, claims 1-18 are under prosecution in this application.

Response to Applicants' Amendment

3. The Examiner acknowledges Applicants' arguments in the remarks regarding the rejection under 35 U.S.C. § 101 and 112 1st which deemed to be not persuasive. Applicants' remaining traversals are discussed under 35 U.S.C. § 101, and 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-18 are rejected under 35 U.S.C. § 101 as discussed in paragraph 5, paper No. 21.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph as discussed in paragraph 7, paper No. 21.

Response to Applicants' Amendment

8. Applicant's arguments filed on April 6, 2005 have been fully considered but they are not persuasive. In response to Applicant arguments;

The Examiner acknowledges Applicant submission of an affidavit under rule 132, "establishing the level of competence of applicant's peers (those skilled in the art) at the time of the invention in late 1995". However, Mr. Hardin's statement explains his own technique for assigning a range of values for each answer in a questionnaire (see line 3 of the affidavit by Mr. Hardin). The question here is clearly not how to program a computer, it is how does the actual program or software (Applicant's own invention) that will be executed on a computer (any computer) perform Applicant's invention?

The question that has been raised by the Examiner and the Board of Appeals in a decision on a related case for the same Applicant is how does Applicant system convert text, essay questions and responses into computer data and how does it take into account all of theses subjective risk factors which the calculation process appears to entail?

Using moral hazard adjustments to obtain a probable success factor are known in the art. However, the instant specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer (Applicant's program or software) to achieve the desired results.

The last page of the remarks, Applicant cites a Board's decision during a preceding Appeal to the Board of Appeals stating, " In commenting on the invention during a preceding Appeal to the Board of Appeals, the Board stated that the calculation of a score for determining the probability of success of undertaking commercialization of an Intellectual Property is clearly a tangible use for a practical result which is attained in the instant claimed invention." Applicant further comments on the decision stating "This statement by the Board leads to the inescapable conclusion that a low score simply means below or less than average and a high probable success factor alternatively means greater than or above average and intuitively one selects a high probable success factor in deciding whether or not to undertake a lawsuit".

In response, it is true that the calculation of a score for determining probability of success in a lawsuit or for determining the relative strength of undertaking commercialization of an Intellectual Property is clearly a tangible, useful and practical result as indicated by the Board. However, the statement by the Board does not lead to the conclusion that a low score simply means below or less than average and a high probable success factor alternatively means greater than or above average. It is Applicant who contends that "This statement by the Board leads to the inescapable conclusion that a low score simply means below or less than average and a high probable success factor alternatively means greater than or above average and intuitively one selects a high probable success factor in deciding whether or not to undertake a lawsuit".

The 112 1st rejection raised by the Examiner deals specifically with Applicant's own disclosure. It is unclear from Applicant's disclosure to what is considered low and what is considered high probable success factor. There is no indication in the specification of how the composite score is used to evaluate the strength of a specific intellectual property, nor how the probable success factor is used in undertaking a lawsuit, the actual step of evaluating the strength of an intellectual property using the score is not performed.

With respect to the rejected under 35 U.S.C. § 101, the Board's decision on patentability under 101 still stands. The rejection given in both the previous and present office actions under 35 U.S.C. § 101 is different than the rejection presented to the Board of Appeals. Claims 1-18 do not produce a "***concrete***" result in the "Method for determining the risk associated with licensing or

enforcing intellectual property". The results (scores) in the present application do not produce ***concrete*** results, it is unclear how the present application expresses the use of the resulting score, and how is it used in representing a relative degree of strength associated with commercializing intellectual properties.

It is Applicant who contends that this statement by the Board yields a useful **concrete** and tangible result. The present rejection was not whether the results are tangible, useful and practical, the rejection is based on concreteness. Applicant's claimed invention is still short on any particular or specific direction or guidance in achieving the desired results and in providing a concrete result.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-irect.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

January 13, 2006